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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,919	03/27/2001	Griffith E. Altmann	P02737	4268

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EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

eb04

Office Action Summary	Application No.		Applicant(s)	
	09/818,919		ALTMANN ET AL	
	Examiner		Art Unit	
	Mathieu D. Vargot		1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-21 and 28-31 is/are allowed.
- 6) ☒ Claim(s) 1-13 and 22-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 17-31, drawn to a method of casting an ophthalmic lens, classified in class 264, subclass 1.36.
- II. Claims 14-16, drawn to a mold assembly, classified in class 249, subclass 134.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice other and materially different processes such as the molding of articles other than lenses—compact disks, plastic medallions and other articles can be made from the molds. Also, the instant mold assembly can be used in methods other than those employing radiation passing through the mold—ie, the molds can be used in methods involving thermal polymerization of the cast monomer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. McGuire on December 18, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13 and 17-31. Affirmation of this election must be made by applicant in

replying to this Office action. Claims 14-16 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. Claims 2-5 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2-5, it should be clearly specified that the pathway of the irradiation is controlled by passing the irradiation through the liquid (claim 2), the controlled concave surface (claim 3) and the optical lens (claims 4 and 5). While claim 1 recites that the radiation is controlled, claims 2-5 in fact actually set forth how this is occurring. However, lacking any recitation to that effect, it is unclear that the recitations in dependent claims 2-5 are actually further defining how the irradiation is controlled. In claim 23, the exact meaning of "similar" is unclear and applicant is requested to more explicitly define same.

3. Claims 2 and 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

4. Claims 17-21 and 28-31 are allowed in that the prior art does not disclose, teach or suggest the overall aspects of casting a lens and curing the formulation by irradiating same through liquid or a lens contained in the concave surface of the posterior mold, whereby the pathway of the radiation is controlled by passing same through the liquid or lens. Claims 2 and 5 would be allowable if put in independent form and pending an obviation of the 112 rejection for the same reason.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (col. 7, lines 18-37; col. 6, lines 47-49).

The applied reference discloses the basic claimed method of making an ophthalmic lens/contact lens by casting a monomer between two molds and curing the monomer by irradiating through the top mold using a diaphragm to control the polymerization, Clarke et al essentially lacking a clear showing of the first mold being made of an amorphous material. The applied reference clearly teaches that the radiation would be passed through the top mold, and it is well known in the art that a mold transparent to the passage of the radiation is required for this. Further, it is also fairly well known in the art that amorphous polymers are generally transparent and hence are better than crystalline polymers in transferring radiation therethrough to the mold cavity. In view of

what is common knowledge in the art, one of ordinary skill would have found it obvious to make the first/top mold of Clarke et al as amorphous to facilitate passing the radiation through the mold.

6. Claims 3 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke et al in view of Neeffe -088 (see 6 in Fig. 1).

Clarke et al is applied for reasons of record as set forth in paragraph 5, supra, the primary reference essentially lacking the aspect of controlling the concave non-molding surface of the first mold portion through which the irradiation passes. Neeffe -088 discloses employing a convex non-molding surface (6) on mold part (2) through which radiation is passed to cure a lens formulation. Note that the surface 6 has a focal length equal to the mold thickness, as set forth at column 1, lines 54-56 of Neeffe -088. In essence, the secondary reference is disclosing controlling the curvature of the non-molding surface of a mold through which radiation passes so the polymerization of the lens formulation is controlled. While the exact shape of the surface (ie, concave or convex) is different, one of ordinary skill in this art would know from Neeffe -088 that non-molding surfaces would be used to direct radiation in a controlled manner towards a mold cavity to controllably cure a lens. It certainly would have been obvious to have employed a controlled curvature mold in Clarke et al as generally taught by Neeffe -088 in lieu of the diaphragm to facilitate control over the lens curing.

7. Claims 4 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke et al in view of Neeffe -915.

Clarke et al is applied for reasons already of record, the primary reference essentially lacking the aspect of employing a lens above the concave surface of the first mold portion through which radiation passes. Neeffe -915 discloses controlling polymerization of a lens formulation by passing irradiation through a lens (1) which is located above a mold containing the formulation. It certainly would have been obvious to have modified the method of Clarke et al by employing a lens above the mold as generally taught by Neeffe -915 in order to focus the radiation as desired and facilitate the curing.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kennedy discloses making lens molds wherein the non-molding surface of one of the molds is controlled.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianne, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
February 3, 2004

M. Vargot
Mathieu D. Vargot
Primary Examiner
Art Unit 1732

2/3/04